

### **REMARKS**

The present concepts expressed by Applicants' disclosure teach, for example, how to secure data, such as documents and drawings, shared by a plurality of machines (e.g., LAN). It is noted that every reference cited by the Examiner in the Office Action, including the newly applied **Sato** reference, relates to counterfeiting of banknotes and similar valuable papers.

One significant difference between the claimed invention and the cited references is found in the step of updating and recording the updating history. Data shared through LANs, for example, are modified frequently (e.g., hour-by-hour or minute-by-minute) and the prohibition information has to be updated at rates according to the modification of data, whereas the prohibition information of banknotes and valuable papers is modified infrequently (yearly or monthly, at most). Thus, the paradigms or theoretical frameworks presented in such cited and applied references and the claimed invention are markedly different (see, e.g., page 2, lines 19-26 of Applicants' specification).

#### **1. CLAIM STATUS**

The Examiner stated that, in rejecting canceled claims 1, 5, 11 and 16, "applicant did not officially instruct the patent office to delete claims 1, 5, 11 and 16".

In accord with 37 CFR 1.121 and the recent publications by the USPTO, the April 11, 2003 Amendment included a complete listing of all claims in the application. After each claim number, the status of the claim was indicated in a parenthetical expression following the claim number. In accord with the current USPTO procedure, the canceled claims were indicated as "(Canceled)". Therefore, the Examiner's statement that the applicant did not instruct the patent office to delete claims 1, 5, 11 and 16 is in error. Such claims were canceled on April 11, 2003 in compliance with 37 CFR 1.121.

In a similar vein, it is noted that the Examiner failed to notice the NEW claims that were added in the April 11, 2003 amendment. As noted above, 37 CFR 1.121 and the USPTO require amendments to include a complete listing of all claims in the application, including new claims. After each claim number, the status of the claim was indicated in a parenthetical expression following the claim number (i.e., the new claims were numbered and indicated as "(New)"). Moreover, the Remarks section also noted that "[n]ew dependent claims have been added" and it was submitted that "the new dependent claims added herein do not introduce any new matter or raise any issues that have not already been fully considered by the Examiner." Therefore, as the prior Office Action was non-final, the Examiner was required to enter and consider these new claims. Allowance of claims 38-41 is requested.

**2. ASSERTED 35 U.S.C. 103 REJECTIONS ARE PRIMA FACIE INVALID**

It is noted that the Examiner cited numerous Japanese-language references in the various 35 U.S.C. 103 rejections set forth in numbered paragraphs 3-7 in Paper No. 11, but did not provide copies of translations thereof or citations to subject matter assertedly contained in the underlying documents.

The Board of Patent Appeals and Interferences has often noted the "recurring problem" of "the citation and reliance by Examiners on abstracts, without citation and reliance on the underlying scientific document". *See Ex Parte Gavin*, 62 USPQ 1680, 1683 (Bd. Pat. App. & Inter. 2001)(Examiner relied upon abstracts of two published Japanese patent applications without referring to translations of the underlying applications); *Ex Parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (Examiner relied upon abstracts of three foreign-language journal articles without referring to translations of the underlying applications); *see also Ex Parte Bontils*, 64 USPQ2d 1456 (2002).

For good reason, the Board is critical of the evidentiary value of such English-language abstracts and conclusions gleaned therefrom. *See, e.g., Ex Parte Gavin* at 1684 (*stating* "an abstract does not provide enough information to permit an objective evaluation of the validity of what it describes . . . . They are little more reliable than headlines or brief newspaper articles"); *Ex Parte Jones* at 1208 (noting "[a]bstracts often are not written by the author of the underlying document and may be erroneous").

The above-noted rejections, which are not expressly stated in terms limiting the scope of the asserted "prior art" to only the English-language abstract, are improperly based upon underlying foreign language documents of which the Examiner has provided no translations and has asserted no personal knowledge thereof rather than the English-language abstracts thereof.

Withdrawal of each of the above-noted rejections I-V is therefore requested for at least the reason that proffered evidentiary support is facially invalid.

**3. THE OBVIOUSNESS REJECTIONS ARE FACTUALLY AND LEGALLY INSUFFICIENT**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art". *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *see also In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)(*stating* "[w]hen evaluating the scope of a claim, every limitation in the claim must be considered").

A *prima facie* case of obviousness requires the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, *or in the form of generally available knowledge at the time of the invention*, that would have led one of ordinary

skill in the art to combine the relevant teachings in the proposed manner to arrive at the claimed invention. *See, e.g., Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *Carella v. Starlight Archery*, 804 F.2d 135 (Fed. Cir. 1986).

For the reasons that follow, it is submitted that the Examiner's burden to set forth a *prima facie* case of obviousness has not been discharged, as broad conclusory statements, standing alone, are not "evidence" supportive of a *prima facie* showing. *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993).

**A. Claims 1-3, 5, 8, 11-13, 17, 19 and 27-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato (JP 01-316783) in view of Funada et al. (JP 5-14706) (hereinafter "Funada").**

The Examiner recognizes the English-language abstract of **Sato** "does not teach copy inhibition information . . . stored in inhibition information storage" and cites the English-language abstract of **Funada** as teaching a "data monitoring method in which updating information of the copy inhibition information is provided passing through a network" (allegedly citing abstract constitution).

However, the English-language abstract of **Funada** does not teach or suggest, as alleged, a "data monitoring method in which updating information of the copy inhibition information is provided passing through a network". Instead, the English-language abstract of **Funada** states:

PURPOSE: To facilitate the decision of various specified pictures by constituting a picture processor of a means to hold the features of the registered specified pictures, the means to decide similarity between the feature of the inputted picture and the feature of the held specified picture, and the means to update held contents from the outside through a line.

CONSTITUTION: The decision of the various specified pictures is facilitated by constituting the picture processor of the means 302 to hold the features of the registered specified pictures, the means 303-1 to 303-8 to decide the similarity between the feature of the inputted picture and the feature of the held specified picture, and updating means 230 and 231 to update the held contents held by the

means 302 from the outside through the line. Thus, the detection of the color distribution and the discrimination of the pattern matching of an object picture are made possible

Applicants submit that **Funada** is concerned with a logarithm, which is not the same as the log history of the present invention. Applicants submit that **Funada** (i.e., the underlying substantive document) instead relates to "logging" or *recording the procedures on the computer* (log-filing). Notably absent from **Funada's** English-language abstract is mention of a "network" upon which the Examiner repeatedly relies (see, e.g., Page 4 of Office Action). To the extent that the Examiner might be selectively interpreting or extrapolating the disclosed means to update held contents "from the outside through a line", the Examiner has not in fact shown any relation of the English-language abstract of **Funada** to a network and has not discharged the burden of showing that such a feature is necessary present therein (i.e., inherent).

Accordingly, the Examiner has not discharged her burden to demonstrate that the combination of the English-language abstracts of **Sato** and **Funada** teaches or suggests each and every feature of the claimed invention, contrary to the Examiner's statement of rejections in reliance thereupon in each of numbered paragraph 3 of Paper No. 11. As noted above, broad conclusory statements, standing alone, are not "evidence" supportive of a *prima facie* showing.

Claims 2 and 8 require, for example, a data monitoring method comprising: activating an information obtaining means automatically at the time of inputting originals; monitoring each copy element of monitoring object data consisting of at least one kind of copy element in accordance with at least one kind of copy element in accordance with at least one kind of copy inhibition information stored in inhibition information storage; inhibition input or output of the monitoring object data if the monitoring determines that said each copy element agrees with a kind of said copy inhibition information; and obtaining the copy inhibition information by means

of the information obtaining means from a master information storage on a network by issuing a request if originals of said copy inhibition information are stored in the master information storage on the network.

In one example thereof, a registration information requesting circuit (e.g., 33) is provided as an information obtaining means and requests the necessary copy inhibition information in accord with the instruction of a printing information analyzing circuit (e.g., 48), and then obtains the master inhibition information (e.g., 65) stored in the master inhibition information storage (e.g., 800) directly from the information disclosing/delivering means (e.g., 62), such as represented in Fig. 11 and described in the specification on page 28, line 21 to page 29, line 4. The advantage realized by such activation of an information obtaining means and corresponding obtaining of the copy inhibition information thereby from a master information storage on a network is, in one aspect, elimination of the need for extra memory on the network for storing the copy inhibition information (e.g., 49) thereby reducing cost. Likewise, since the copy inhibition information (e.g., 49) of a network printer(s) (e.g., 4) can be updated by updating the master inhibition information (e.g., 65), it is easy and quickly manage and update the copy inhibition information (see, e.g., page 29, lines 5-10 of specification).

**Funada's** English-language abstract's teaching of updating held contents "from the outside through a line" fails to state *when* an updating request is issued and does not teach or suggest "activating an information obtaining means automatically at the time of inputting originals" or "obtaining the copy inhibition information by means of the information obtaining means from a master information storage on a network by issuing a request if originals of said copy inhibition information are stored in the master information storage on the network," which are recited in claims 2 and 8.

Similarly, the English-language abstract of **Funada** has not been shown to teach or suggest a data monitoring device comprising "a log storage storing updating logs when the copy inhibition information in the inhibition information storage are updated; and in which the updating means obtains the latest copy inhibition information based on the logs of the updating information" (claim 17) or "monitoring means activating an information obtaining means automatically at the time of inputting originals and monitoring at least one kind of copy element prepared from monitoring object data based on the copy inhibition information; a master information storage on the network storing originals of the copy inhibition information; and information obtaining means obtaining the copy inhibition information from said master information storage on a network by issuing a request" (claims 12, 13, 17 and 19).

The English-language abstract of **Funada** also has not been shown to teach or suggest a copying device receiving an monitoring object data from an external device and preparing a copy based on the monitoring object data, comprising: extracting means analyzing the monitoring object data and extracting unique information specifying a specific device concerned with the preparation of the monitoring object data; and specific information imparting means imparting the extracted unique information to the monitoring object data (claim 27) or such device "in which the unique information is an ID number specifying a personal computer" (claim 28) or "in which the unique information is an IP address imparted to a device." (claim 29).

In view of the above, it is submitted that the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), as the cited and applied combination of references does not teach or suggest each and every element of the aspects of the invention claimed in claims 2, 8, 12-13, 17, 19 and 27-29 (claims 1, 3, 5 and 11 being cancelled) for want

of a *prima facie* case of obviousness. Withdrawal of this 35 U.S.C. § 103 rejection is requested for at least the above-described reasons.

**B. Claims 4, 14-16 and 34-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Funada and Takagi (JP 5-282448).**

It is submitted that this 35 U.S.C. § 103 rejection premised upon the English-language abstracts of **Sato** and **Funada** is factually and legally insufficient, in combination with the English-language abstract of **Takagi**, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 as the English-language abstract of **Takagi** has not been shown to cure the deficiencies of the English-language abstracts of **Sato** and **Funada**, which are expressed above but otherwise omitted herein for brevity.

As noted above, claims 4 and 14-16 are canceled herein.

The 35 U.S.C. § 103 rejection of claims 34 and 35 are further traversed on the following additional grounds.

As to claims 34 and 35, the combination of the English-language abstracts of **Sato**, **Funada** and **Takagi** has not been shown to teach or suggest a storage medium storing a program or programs comprising an instruction set requiring execution of the steps of activating an information obtaining means automatically at the time of inputting originals; and obtaining the copy inhibition information by means of the information obtaining means from a master information storage on a network by issuing a request if originals of said copy inhibition information are stored in the master information storage on the network.

In view of the above, it is submitted that the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), as the cited and applied combination of references does not teach or suggest each and every element of the claimed invention and as the



Examiner has failed to establish a *prima facie* case of obviousness. Withdrawal of this 35 U.S.C. § 103 rejection is requested for at least the above-described reasons.

**C. Claims 7, 9-10, 18 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Funada and Ishii (JP 2-073284).**

It is submitted that this 35 U.S.C. § 103 rejection premised upon the English-language abstracts of **Sato** and **Funada** is factually and legally insufficient, in combination with the English-language abstract of **Ishii**, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 as the English-language abstract of **Ishii** has not been shown to cure the deficiencies of the English-language abstracts of **Sato** and **Funada**, which are expressed above but otherwise omitted herein for brevity.

The 35 U.S.C. § 103 rejection of claims 7, 9-10, 18 and 20 are further traversed on the following additional grounds.

Further to claim 8, the factual deficiencies underlying the teachings and suggestions of the combination of the English-language abstracts of **Sato** and **Funada** being noted above, dependent claim 7 recites “controlling a copy inhibition or an inhibition cancel in accordance with secrecy management information and user’s secrecy management level, said secrecy management information stored in the inhibition information storage in addition to the copy inhibition information in advance.”

Dependent claim 7 encompasses, for example, a document imparted with a security level depending on a person’s position in a company and categories of documents to which they are provided access for browsing. Thus, there would exist documents that everyone could browse, documents that all of specific section members are allowed to browse, documents that specific

titled persons of a specific section are allowed to browse, and so on. Such security level is imparted to each document or each part of said document (see Fig. 13). In order to cancel the "protected status" (for example, a status that a flag is standing) of a specific copy protected data, it is general that the protected status by inserting a specific person's card to the card slot. However, in case where a specific copy protected document is concerned with the security level of the document and an individual's post and title, like those in the present invention, it is necessary to decide whether the copy protection is cancelled or not by checking the security level of the document and an individual's attributes (his or her post and title).

The English-language abstract of **Ishii**, relied upon by the Examiner in the rejection of claims 7, 9-10, 18 and 20 fails to teach or suggest "controlling a copy inhibition or an inhibition cancel in accordance with secrecy management information and user's secrecy management level, said secrecy management information stored in the inhibition information storage in addition to the copy inhibition information in advance" (claim 7), "controlling a copy inhibition or an inhibition cancel in accordance with secrecy management information and user's secrecy management level, said secrecy management information obtained together with the copy inhibition information at the step of obtaining the information, said secrecy management information stored in the master inhibition information storage in addition to the original copy inhibition information in advance" (claim 9), or "canceling a function of stopping the copying after confirming if a user has a right to cancel the monitoring function or not" (claim 10).

The English-language abstract of **Ishii** also fails to teach or suggest "secrecy management means storing in the inhibition information storage secrecy management information in addition to the copy inhibition information, and controlling a copy inhibition or a inhibition cancel in

accordance with secrecy management information and user's secrecy management level" (claim 18).

The English-language abstract of **Ishii** also fails to teach or suggest a master storage which "stores secrecy management information of each original information in addition to the copy inhibition information," "information obtaining means obtains the copy inhibition information and the secrecy management information"; and "secrecy management means controlling a copy inhibition or a inhibition cancel in accordance with the obtained secrecy management information and user's secrecy management level." (claim 20).

The Examiner's recitation of the claim language fails to amount to "a teaching or suggestion" *in the asserted reference*, that the English-language abstract of **Ishii** in fact teaches or suggests the asserted claim limitations. As noted previously, broad conclusory statements, standing alone, are not "evidence" supportive of a *prima facie* showing. *McElmurry v. Arkansas Power & Light Co., supra*.

The cited passages in the English-Language "Purpose" and "Constitution" of **Ishii** show, in contrast to the Examiner's assertions, that the decision as whether the copy protection is cancelled or not is based only upon an ID number given to a user to "prevent unauthorized use of the title device" (i.e., not to prevent unauthorized copy of copy inhibition information).

The aforementioned claims variously recite one or more of "secrecy management means", "secrecy management information", and "secrecy management level" in various contexts and combinations. The relation between these secrecy management tools and the copy inhibition information is shown, by way of example, in Figure 13, which shows secrecy management information (e.g., 67) inputted together with the master inhibition information (e.g.,

65). Thus, contrary to claims at issue, the English-language abstract of **Ishii** does not impart or assign a security level to a document itself or associate secrecy management information with a specific copy inhibition information. The English-language abstract of **Ishii** therefore fails to teach or suggest, for example, the claimed aspects and combinations of the “secrecy management means”, “secrecy management information”, and “secrecy management level”.

In view of the above, it is submitted that the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), as the cited and applied combination of references does not teach or suggest each and every element of the claimed invention and as the Examiner has failed to establish a *prima facie* case of obviousness. Withdrawal of this 35 U.S.C. § 103 rejection is requested for at least the above-described reasons.

**D. Claims 21-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Funada and Omura (JP 4-03120561A).**

It is submitted that this 35 U.S.C. § 103 rejection premised upon the English-language abstracts of **Sato** and **Funada** is factually and legally insufficient, in combination with the English-language abstract of **Omura**, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 as the English-language abstract of **Omura** has not been shown to cure the deficiencies of the English-language abstracts of **Sato** and **Funada**, which are expressed above but otherwise omitted herein for brevity.

The 35 U.S.C. § 103 rejection of claims 21-26 are further traversed on the following additional grounds.

As to claim 21, the English-language abstract of **Omura** is alleged to teach “a data monitoring device comprising canceling means canceling a function of stopping the copying

after confirming if a user has a right to cancel the monitoring function or not.” The English-language “Purpose” of **Omura**, in fact, teaches “[t]o allow copying only to limited users . . . by inputting a code to release copying prohibition and allowing the copying”. The English-language “Constitution” of **Omura** teaches that “copying is possible only for limited users”.

Claim 21 recites a data monitoring device comprising: monitoring means activating an information obtaining means automatically at the time of inputting originals and monitoring at least one kind of copy element prepared from monitoring object data based on the copy inhibition information; inhibition means inhibiting input or output of the monitoring object data if said at least one copy element included in the monitoring object data agrees with one of the copy inhibition information; a master information storage on the network storing originals of the copy inhibition information; information obtaining means obtaining the copy inhibition information from said master information storage on a network by issuing a request; updating means updating the copy inhibition information; and canceling means canceling a function of stopping the copying after confirming if a user has a right to cancel the monitoring function or not.

As noted above, the combination of the English-language abstracts of **Sato** and **Funada** is factually and legally insufficient, in combination, to teach or suggest “monitoring means activating an information obtaining means automatically at the time of inputting originals and monitoring at least one kind of copy element prepared from monitoring object data based on the copy inhibition information; a master information storage on the network storing originals of the copy inhibition information; and information obtaining means obtaining the copy inhibition information from said master information storage on a network by issuing a request” (Independent claim 19, dependent claim 21). The English-language abstract comprising the

“Purpose” and “Constitution” of **Omura** is submitted to be unable to make up for this evidentiary deficiency and the combination of the English-language abstracts of **Sato, Funada,** and **Omura** is submitted not to teach or suggest each of the above-noted elements of claim 21. Withdrawal of this 35 U.S.C. 103 rejection is requested for at least this reason.

Further, the claimed “data monitoring device comprising canceling means canceling a function of stopping the copying after confirming if a user has a right to cancel the monitoring function or not,” which generally relates to the disclosure on pages 30-31 of Applicants’ disclosure, is shown in Fig. 11 by way of example. Fig. 11 shows a block diagram illustrating a method for canceling the unauthorized copy preventing function of a device comprising the data monitoring function. Applicants teach that, for the maintenance of the device, or for other reasons, there is a need for canceling the unauthorized copy preventing function (see page 30, lines 5-6). A user having a right to cancel the function is able to instruct the printing information analyzing circuit 15 (28, 55) to stop its function via a prevention canceling circuit 17 *so as stop the function* preventing the unauthorized copy (see page 30, lines 6-11). Thus, it is possible to accommodate various management conditions such as organizational changes, movement of apparatuses, or the change of secrecy levels, for example, as well as the maintenance of the devices (see page 30, lines 21-26). The aforementioned and claimed “canceling means canceling a function of stopping the copying” thus relates to the cancellation of the function of stopping the copying and does not relate to the inhibition of a copying operation itself to limited users, as taught by the English-language abstract of **Omura**.

As to independent claims 22 and 25, Applicants submit that the Examiner's comments regarding the English-language abstract of **Omura** on page 9 of the Office Action are incorrect. Applicants submit that, in the underlying substantive document of **Omura**, data that is to be an

object of the copying does not contain either of created ID information, chip ID information, and mail address, as asserted by the Examiner. Consequently, **Omura** does not, whether taken singly or in combination with the teachings of the English-language abstracts of **Sato** and **Funada**, cure the factual deficiencies of the base references and therefore does not teach or suggest the claimed invention for at least the reason that the proffered combination does not teach or suggest a copying device comprising "first specific information extracting means extracting an ID information unique to a specific device concerned with the preparation of monitoring object data; and information imparting means imparting the ID information to the monitoring object data and preparing a new copied data" (claim 22) or "second specific information extracting means extracting a specific application information unique to software concerned with the preparation of monitoring object data; and information imparting means imparting the specific application information to the monitoring object data and preparing a new copied data."

Further, the English-language abstracts of **Omura** and **Funada** teach that the image that is an object of the copying is compared to a copy inhibition image and, if the two images are in accord with one another, the copying is inhibited. In the English-language abstract of **Sato**, instead of inhibition, a transformation of the image is executed (e.g., the color is changed). Applicants disclose and claim a method of imparting to the read-out image of an ID of the apparatus that engaged in the reading, such as a chip ID and IP address, which is significantly different from the above-cited references wherein the output of the image itself is inhibited, or if the image is output, the content of the image is altered. Thus, the claimed invention can specify the apparatus that engaged in the copying, but the cited and applied references cannot, in any combination, achieve such purpose, nor is such taught or suggested by any or all of the references, however taken.

In view of the above, it is submitted that the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), as the cited and applied combination of references does not teach or suggest each and every element of the claimed invention and as the Examiner has failed to establish a *prima facie* case of obviousness. Withdrawal of this 35 U.S.C. § 103 rejection is requested for at least the above-described reasons.

**E. Claims 30-33 and 36-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Funada and Ugai (JP 4-06125459A).**

It is submitted that this 35 U.S.C. § 103 rejection premised upon the English-language abstracts of **Sato** and **Funada** is factually and legally insufficient, in combination with the English-language abstract of **Ugai**, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 as the English-language abstract of **Ugai** has not been shown to cure the deficiencies of the English-language abstracts of **Sato** and **Funada**, which are expressed above but otherwise omitted herein for brevity.

The 35 U.S.C. § 103 rejection of claims 30-33 and 36-37 are further traversed on the following additional grounds.

As to independent claims 30, 33, 36 and 37 Applicants submit that **Ugai** is configured so as to provide a mark on a back of a recording paper when a copy protected information is printed out. The Examiner's detailed (i.e., mirroring the claim language) suppositions regarding the possible meanings behind the English-language abstract of **Ugai** are factually unsupported and insufficient to substantiate or support a *prima facie* case of obviousness.

The present invention is configured so that the analyzing means extract identifier information, such as chip ID information, IP address and mail address, those given to PC



concerned with the printing data printed by the printer device, and then add such data to the copy objective data. Claim 30 recites a copying device comprising "extracting means analyzing the copied data and extracting unique information specifying specific software concerned with the preparation of the copied data; and specific information imparting means imparting the extracted unique information to the copied data as new copied data." Claim 33 recites a copying device comprising "extracting means extracting an IP address imparted to the copying device; and specific information imparting means imparting the extracted IP address to the copied data as new copied data." Claim 36 recites "extracting ID information unique to a specific device concerned with the preparation of the monitoring object data; and imparting the ID information to the monitoring object data and preparing a new copied data". Claim 37 recites "extracting specific application information unique to software concerned with the preparation of the monitoring object data; and imparting the specific application information to the monitoring object data and preparing a new copied data".

None of the aforementioned claim elements are taught or suggested by the English-language abstract of Ugai's teaching of deciding a "mark addition" (see English-language "Constitution" of Ugai). Applicants submit that the English-language abstract of Ugai does not, whether taken singly or in combination with the teachings of the English-language abstracts of Sato and Funada, cure the factual deficiencies of the base references and therefore does not teach or suggest the claimed invention for the reasons noted above. The English-language "Purpose" and "Constitution" of Ugai merely teach that the image that is to be an object of the copying is compared with a copy inhibition image, and the similarity of those images are judged. According to the level of the similarity, the objective image is inhibited from copying or is otherwise imparted with a marking.

As noted above, the present invention is, as variously claimed, designed to impart an ID for specifying the software engaging the copying of the image data obtained from the external apparatus after analyzing the objective image data, the ID being the registration information of the software, for example. Therefore, the teachings of the English-language abstract of **Ugai** are different from that of the claimed invention. As one example, the elements of the claimed invention permit, in combination, identification of the apparatus that was used to perform the copying. The English-language abstract of **Ugai**, whether taken singly or in combination with the other cited and applied references, can not achieve this purpose, nor is identification of the apparatus used to perform the copying taught or suggest thereby. Moreover, in accord with the claimed invention, even when the image data is copied as electronic data, the claimed combination of elements permits identification of the apparatus used to perform the copying.

In view of the above, it is submitted that the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), as the cited and applied combination of references does not teach or suggest each and every element of the claimed invention and as the Examiner has failed to establish a *prima facie* case of obviousness. Withdrawal of this 35 U.S.C. § 103 rejection is requested for at least the above-described reasons.

**4. EXAMINER'S BURDEN OF PROOF HAS NOT BEEN DISCHARGED**

The ultimate determination on patentability is made on the entire record. *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). As part of this determination, Examiner's are to consider all rebuttal arguments and evidence presented by applicants. *See, e.g., In re Soni*, 54 F.3d 746, 750 (Fed. Cir. 1995); *In re Alton*, 76 F.3d 1168 (Fed. Cir. 1996). "A determination under 35 U.S.C. § 103 should rest on all evidence and should not be influenced by any earlier conclusion." *See, e.g., In re Piasecki*, 745 F.2d 1468, 1474 (Fed. Cir. 1984).

"When an applicant submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of the evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence". See, e.g., MPEP § 716.01(d)(emphasis added). "Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself." *In re Eli Lilly*, 902 F.2d 943 (Fed. Cir. 1990)(emphasis added).

In the Amendment filed April 11, 2003, Applicants presented evidence pointing out the factual deficiencies in the teachings of the asserted references, including discussion of the factual deficiencies of the English-language abstracts of **Funada et al.** (JP 5-14706), **Ishii** (JP 2-073284), **Omura** (JP 4-03120561A), and **Ugai** (JP 4-06125459A).

The Examiner's "Response to Arguments" presented in the present Office Action (Paper No. 11, Page 10) asserted that "Applicant's arguments are moot in view of the new grounds of rejection" since the primary reference "has been replaced by Sato which also teaches inhibiting copying of illegal data [sic: data]".

Despite Applicants' earnest efforts to highlight the differences between the claimed invention and the applied references, the Examiner has impermissibly ignored all of Applicants' remarks and evidence pertaining to all of the references supplemental to the primary reference.

"Wherever the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements about the arguments being moot in view of a substitution of one reference in asserted combinations of references are insufficient. MPEP § 716.01 (emphasis added).

In view of the above, it is submitted that the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), as the Examiner has not considered the record in its entirety in arriving at the conclusion of obviousness or has not provided evidence of such consideration. The Examiner's rebuttal, comprising a reassertion of alleged obviousness under 35 U.S.C. § 103, is lacking in premise or basis in the record as a whole, as it improperly dismisses the substance of the Applicants' rebuttal evidence, draws conclusions not permitted by the facts of record, and fails to provide explanation of such conclusions.

Withdrawal of this 35 U.S.C. § 103 rejection is requested for at least this reason.

5. ALLOWANCE OF CLAIMS 38-41 REQUESTED

The Examiner failed to state a ground of rejection for claims 38-41. Allowance of claims 38-41 is accordingly requested.

6. CLOSING REMARKS

Allowance of all of the pending claims is requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit excess fees to such account.

Respectfully submitted,

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